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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,691	12/27/1999	TERRY HERMISTON	ONYX1022	9088

7590

01/09/2004

GREGORY GIOTTA PH.D  
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3031 RESEARCH DRIVE  
RICHMOND, CA 94806

EXAMINER
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WHITEMAN, BRIAN A

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/472,691	<b>Applicant(s)</b> HERMISTON ET AL.	
	<b>Examiner</b> Brian Whiteman	<b>Art Unit</b> 1635	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/28/03.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6, 12-14 is/are allowed.
- 6) ☒ Claim(s) 7-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
     a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### **Final Rejection**

Claims 1-14 are pending examination.

The Applicants' traversal, the amendment to claims 1-4, 7 and 10, the cancellation of claim 15 in paper no. filed on 10/28/03 is acknowledged and considered.

NOTE: The status of Claim 10 (currently) and the statement "Please cancel" in claim 15 are not considered to be in proper format under the new guidelines for filing an amendment to the claims under 37 CFR 1.121. Suggest following the new guidelines under 37 CFR 1.121 when filing an amendment. See MPEP 714.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 7-11 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7, 8, 9, and 10-11 recite the limitation "said adenoviral vectors". There is insufficient antecedent basis for this limitation in the claim. Claims 1, 5, 6, or 15 recite "adenoviral vector". Suggest replacing the phrase with -- said adenoviral vector -- .

Applicants did not argue the rejection of claims 7-11 under 112 second paragraph.

*Response to Arguments*

Applicant's arguments, see, filed 10/28/03 with respect to claim objection have been fully considered and are persuasive. The objection of claims 2, 3, 4, and 15 has been withdrawn because of the cancellation of claim 15 and the amendment to claim 2-4.

Applicant's arguments, see, filed 10/28/03 with respect to 112 first paragraph enablement have been fully considered and are persuasive. The rejection of claims 1, 2, 3, 4, 6, 7, 9, 10, and 11 has been withdrawn because of the cancellation of claim 15 and the amendment to claims 1, 2, 3, 4, 6, 7, 9, 10, and 11.

Applicant's arguments, see, filed 10/28/03 with respect to 112 second paragraph enablement have been fully considered and are persuasive. The rejection of claims 2, 3, 4, 5, 6, and 11 has been withdrawn because of the amendment to claims 2, 3, 4, 5, 6, and 11.

Applicant's arguments, see, filed 10/28/03, with respect to 102(e) rejection have been fully considered and are persuasive. The rejection of claims 1, 6, 7, 9, 10, 11, 14, and 15 has been withdrawn because of the amendment to claim 1 and the cancellation of claim 15.

Applicant's arguments, see, filed 10/28/03, with respect to 103(a) rejection have been fully considered and are persuasive. The rejection of claims 1, 2, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13,

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14 and 15 has been withdrawn because of the amendment to claim 1 and the cancellation of claim 15.

***Conclusion***

Claims 1, 2, 3, 4, 5, 6, 12, 13, and 14 are in condition for allowance because the claims are free of the prior art of record.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Whiteman whose telephone number is (703) 305-0775. The examiner can normally be reached on Monday through Friday from 7:00 to 4:00 (Eastern Standard Time), with alternating Fridays off.

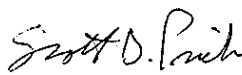
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang, acting SPE - Art Unit 1635, can be reached at (703) 306-3217.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Brian Whiteman  
Patent Examiner, Group 1635

  
**SCOTT D. PRIEBE, PH.D**  
**PRIMARY EXAMINER**